

REMARKS

The Final Office Action dated August 13, 2008 contained a final rejection of claims 1-4 and 10-20. The Applicants have amended claims 1, 10 and 11. Claims 1-4 and 10-20 are in the case. Please consider the present amendment with the attached Request for Continued Examination (RCE) under 37 C.F.R. § 1.114. This amendment is in accordance with 37 C.F.R. § 1.114. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action rejected claims 1-8 and 18-23 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Roztocil (U.S. Patent Publication No. 2001/0044868) in view of Kemp (U.S. Patent Publication No. 2001/0078160). The Office Action rejected claims 3 and 13 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Roztocil and Kemp.

The Applicant respectfully traverses these rejections and submits that the combined cited references does not disclose, teach or suggest all of the elements of the Applicant's newly amended independent claims.

Specifically, the Applicant's newly amended independent claims now include automatically checking for common errors associated during a prepress stage by automatically pre-flighting the document to be printed, automatically revising incorrect printing instructions and adding missing printing instructions and automatically providing a remote proofing function for a customer of the document to be printed and automatically tracking the printing of the document by continuously monitoring and updating a status of the document to be printed. Support for these amendments can be found throughout the specification, and in particular, in paragraphs [0025] - [0038] of the Applicant's specification as originally filed.

In contrast, the combined references simply disclose allowing a customer to submit a job during job origination by either physically delivering to the print shop one or more documents in hard copy or electronic form or by transmitting the one or more documents to the print shop via the Internet (see paragraph [0022] of Roztocil) and a system and method for printing over the Internet, which includes a client, a service provider, and a portal (see paragraph [0035] of Kemp).

Although Roztocil discloses workflow 200 that includes a preflight stage 204 that is performed using a workflow management software program that executes on

a job preparation workstation 116 at the print shop (see paragraph [0036] of Roztocil), the program in Roztocil merely allows operators at the print shop to obtain data about the various output devices 122 of the print shop, including their availability and capabilities (see paragraph [0045] of Roztocil).

Clearly, this is very far from the Applicant's newly claimed automatically checking for common errors associated during a prepress stage by automatically pre-flighting the document to be printed, **automatically revising incorrect printing instructions** and adding missing printing instructions, automatically providing a remote proofing function for a customer of the document to be printed and automatically tracking the printing of the document by continuously monitoring and updating a status of the document to be printed.

Instead, the combined references disclose that all aspects of the production work flow are performed at the print shop using its network, using workflow management software to simply obtain data on devices in the print shop (see paragraphs [0023-0033] of Roztocil) and requiring the client to submit queries to the portal when locating a suitable service provider by using job tickets (see paragraphs [0043], [0053] and [0056] of Kemp).

Moreover, the Examiner is reminded that the references should not be considered together with the benefit of hindsight. Improper hindsight occurs when knowledge and advantages from the Applicant's disclosure is used, or words or phrases are arbitrarily picked and chosen from references to recreate the Applicant's invention. Crown Operations International, Ltd. v. Solutia, Inc., 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). In particular, the combination of elements in a manner that reconstructs the Applicant's invention only with the benefit of **hindsight** is insufficient to present a *prima facie* case of obviousness. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

Even if the references in question seem relatively similar "...the opportunity to judge by hindsight is particularly tempting. Hence, the tests of whether to combine references need to be applied rigorously," especially when the Examiner uses a reference that does not explicitly disclose the exact elements of the invention from all of the Applicant's independent claims. McGinley v. Franklin Sports Inc., 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001).

Therefore, because the combined cited references are missing at least one feature of the independent claims and because hindsight cannot be used, the

Applicant submits that a prima facie case of obviousness does not exist. As a result, the independent claims are patentable over the combined references. As such, withdrawal of the obviousness rejections of the claims is respectfully requested.

Further, with regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on the same basis. (MPEP § 2143.03). As such, withdrawal of the obviousness rejection of the claims is respectfully requested.

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicants kindly requests the Examiner to telephone the Applicant's attorney at **(818) 885-1575**. Please note that all mail correspondence should continue to be directed to:

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